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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/469,670	12/22/1999	FREDERICK H. SKOOG	23106/74075	5255

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EXAMINER

ODLAND, DAVID E

ART UNIT PAPER NUMBER

2662

DATE MAILED: 05/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/469,670

Applicant(s)

SKOOG, FREDERICK H.

Examiner

David Odland

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 17 May 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
(a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ they raise the issue of new matter (see Note below);
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☒ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1-6.

Claim(s) withdrawn from consideration: _____

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____


HASSAN KIZOU

SUPERVISORY PATENT EXAMINER

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Continuation of part 2d (NOTE): The Applicant has attempted to add claims 7-10 without canceling a corresponding number of finally rejected claims.

Continuation of 5c: the Applicant's arguments are not persuasive.

On page 5 the Applicant argues that the nowhere in Onishi is a transport interface described. The Examiner respectfully disagrees. Onishi clearly discloses a router bus that transports data and is interfaced by, *inter alia*, an RM Router Manager (see items 1 and 2 in figure 1).

On page 6, the Applicant contends that the Office action cites no references that state adding APIs to DRC and PFP drivers would reduce the development costs and make the system more reliable. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves *or in the knowledge generally available to one of ordinary skill in the art*. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, APIs (Application Programming Interfaces) are established and standardized higher layer programs that provide users of a system with a way to communicate with and control lower layer functions (see Appendix A of the previous Office action mailed 02/17/2004 (paper number 9), for a definition of API from *Newton's Telecom Dictionary 12th Edition*, copyright 1997). Furthermore, using existing and established programs, such as APIs, in a system are generally known in the art to reduce the developmental cost of the system since the programs already exist and are standardized. Therefore, it would have been obvious to a

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skilled artisan at the time of the invention to implement API's in the Onishi system because doing so would allow the system to conform to an already existing standard, thus reducing developmental costs. Furthermore, as pointed out in the definition of an API, these programs are used at a higher-layer in order to perform lower layer operations, wherein they are implemented as a Windows program and have icons, menus that are part of a Graphical User interface (GUI). Therefore, it would have been obvious to a skilled artisan at the time of the invention to use API's in the Onishi system doing so would make Onishi more user-friendly by allowing the users to control the router using this higher-layer, GUI-based user-friendly interface.

Also, on page 6 the Applicant exhorts that the only motivation to add API's to a DRC driver and PFP driver are found in the Applicants specification. The Examiner respectfully disagrees. The motivation relied upon by the Examiner is not found in the present application. It must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only *knowledge which was within the level of ordinary skill at the time the claimed invention was made*, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). The Examiners motivation for using API's in the Onishi system was to reduce developmental costs and make the system more user-friendly. Namely, the previous office action states "...It would have been obvious to one skilled in the art at the time of the invention to use API's in the system of Onishi because API's are existing software units used by higher layer applications to perform lower layer operations, therefore the use of this existing software would reduce the developmental cost of Onishi since entirely new methods of handling lower layer operations do not need to be created

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and thus allow Onishi to conform to an established standard. Furthermore, having API's will make the Onishi more user-friendly, thus making it easier to use."

Lastly, on page 6 the Applicant argues that "The Onishi reference merely discloses the known methods of system specific IP routers that do not lend themselves to being portable to multiple operating environments, as stated in the present application at page 2, lines 9 and 10."

However, this feature of the Applicants invention is not recited in the rejected claim(s).

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).